

pointed to a teaching or suggestion in Clark of a lubricant "consisting essentially of" a "dispersion in a carrier fluid" of "at least one fatty acid soap comprising **lithium**." Claim 33, emphasis added. The examiner has not pointed to a teaching or suggestion in Clark of a lubricant "consisting essentially of" a "dispersion in a carrier fluid" of "**stearate** comprising at least one alkali metal having a valence of 1." Claim 47 (emphasis added). The examiner certainly has not pointed to a teaching or suggestion in Clark of a lubricant "consisting essentially of" a "dispersion of **lithium stearate** in a carrier fluid." Claim 58 (emphasis added).

The examiner has not made particular findings as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected the claimed components for combination in the manner claimed. *In re Kotzab*, 55 U.S.P.Q.2d at 1317-1318. *Id.* The examiner certainly has not provided a "finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of [Applicant's] invention to make the combination in the manner claimed." *Id.* at 1318.

The examiner has not established a case of *prima facie* obviousness of amended claims 1-62 over Clark. The citation of Chesser does not overcome the foregoing deficiencies. Applicant respectfully requests that the rejection of claims 1-62 over Clark be withdrawn.

-Claims 63-120

With respect to claims 63-120 directed to a drilling fluid system, the full text of the relevant portion of Clark reads as follows:

Derivatives of the above described fatty acids may also be utilized in the present invention. Such derivatives include alkali, alkaline earth, or transition metal substituted fatty acids; oxidized fatty acids; amides of fatty acids; salts of fatty acids; esters of fatty acids; sulfated fatty acids; sulfonated fatty acids; alkoxylated fatty acids; phosphatized fatty acids; and mixtures thereof.

Clark, col. 5, ll. 56-62. Clark's list of suitable derivatives of fatty acids for use in his "oil-in-water emulsion well fluid" includes many other derivatives besides alkali metal derivatives.

The examiner has not pointed to a teaching or suggestion that would motivate a person of ordinary skill in the art to select alkali metal derivatives for use in Clark's oil-in-water emulsion fluids for any particular reason. In fact, when addressing the issue of preferred fatty acid derivatives, Clark states that:

Preferably, the fatty acid derivatives utilized in the present invention are oxidized fatty acids, esters of fatty acids, sulfated fatty acids and sulphonated fatty acids. Most preferably, the fatty acid derivatives utilized in the present invention are oxidized fatty acids and esters of fatty acids.

Clark, col. 5, ll. 62-67.

The examiner certainly has not pointed to a teaching or suggestion in Clark of the following limitations in the pending claims:

Claim	Limitation
63	a dispersion comprising a quantity of at least one fatty acid soap comprising at least one alkali metal selected from the group consisting of lithium, potassium, rubidium, cesium, and combinations thereof
79	a dispersion comprising a quantity of at least one fatty acid soap comprising lithium
97	a dispersion comprising a quantity of at least one fatty acid soap comprising stearate
111	A drilling fluid system comprising a dispersion comprising a quantity of lithium stearate

The examiner therefore has not pointed to a teaching or suggestion of the invention defined by the claims in Clark. *In re Vaack*, 20 U.S.P.Q.2d at 1442.

The examiner also has not established that a person of ordinary skill in the art would have been motivated to modify Clark in the manner suggested by the examiner. The examiner has not made "particular findings as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected the claimed components for combination in the manner claimed." *In re Kotzab*, 55 U.S.P.Q.2d at 1317. The examiner certainly has not provided a "finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of [Applicant's] invention to make the combination in the manner claimed." *Id.* at 1318. Maintenance of the rejection would fail to consider the invention as a whole, as required under 35 U.S.C. § 103., *Jones v. Hardy*, 220 U.S.P.Q. 1021, 1025 (Fed. Cir. 1984).

Even assuming—for purposes of argument only—that a person of ordinary skill in the art were to select an alkali metal derivative for use as the fatty acid in Clark, the examiner still has

not established that the result would be a "continuous phase" comprising a "dispersion" of the alkali metal derivative of fatty acid, as required by claims 63-120 and 125-126. **Clark's fatty acid derivatives are described as suitable for use in or as the "oil phase" of Clark's "oil-in-water" emulsion.** Clark, Col. 4, ll. 45-54.

The examiner has not pointed to a teaching or suggestion of the invention of claims 63-120. The citation of Chesser does not overcome the foregoing deficiencies. Applicant respectfully requests that the rejection of claims 63-120 over Clark be withdrawn.

-Claim 121

With respect to method claim 121 and claims depending therefrom, the examiner has not pointed to a teaching or suggestion in Clark of a method comprising "exposing at least one metal surface of said drilling equipment to a fluid comprising a dispersion comprising a quantity of at least one fatty acid soap comprising at least one alkali metal." Claim 121, emphasis added. The examiner has not pointed to a teaching or suggestion in Clark of such a drilling fluid system where "said dispersion comprising a quantity of at least one fatty acid soap comprising at least one alkali metal selected from the group consisting of lithium, potassium, rubidium, cesium, and combinations thereof." New claim 123. Nor has the examiner pointed to a teaching or suggestion in Clark of such a drilling fluid system where the fatty acid soap is lithium stearate. Claim 122.

The examiner also has not established that a person of ordinary skill in the art would have been motivated to modify Clark in the manner suggested by the examiner. The examiner has not made "particular findings as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected the claimed components for combination in the manner claimed. *In re Kotzab*, 55 U.S.P.Q.2d at 1317. The examiner has not provided a "finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of [Applicant's] invention to make the combination in the manner claimed." *Id.* at 1318. The examiner certainly has not pointed to a teaching or suggestion of a reasonable expectation that exposure of drilling equipment to such a dispersion would be "effective to produce a coherent lubricating film on said metal surface." Claim 121.

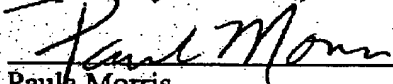
Maintenance of the rejection would fail to consider the invention as a whole. Under 35 U.S.C. § 103: *Jones v. Hardy*, 220 U.S.P.Q. 1021, 1025 (Fed. Cir. 1984). The citation of Chesser does not overcome the foregoing deficiencies.

Applicant respectfully requests that the rejection of claim 121-122 over Clark be withdrawn.

CONCLUSION

For all of the foregoing reasons, Appellant respectfully requests that the obviousness rejection be withdrawn. The Commissioner is hereby authorized to charge any fees in connection with this paper, or to credit any overpayment, to Deposit Account No. 02-0429 (154-28553), maintained by Baker Hughes Incorporated

Respectfully submitted,



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